



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,222	09/25/2006	Theophil Markus Lutz	930024-2031	6514

7590 06/02/2008  
Frommer Lawrence & Haug  
745 Fifth Avenue  
New York, NY 10151

EXAMINER
----------

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
----------	--------------

1793

MAIL DATE	DELIVERY MODE
-----------	---------------

06/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,222	<b>Applicant(s)</b> LUTZ ET AL.	
	<b>Examiner</b> Anthony J. Green	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/01/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment submitted on 01 April 2008. Claims 14-27 have been added and accordingly claims 14-27 are currently pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (US Patent No. 2005/0258401 A1) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not rendered obvious by the reference as the substitution of lithium glycerophosphate for the sodium glycerophosphate of the reference is based on hindsight.

It is the position of the examiner that it would have been obvious to substitute one alkali metal glycerophosphate for another as one would expect them to have similar properties in the absence of evidence to the contrary. Applicant has not shown that the substitution of lithium glycerophosphate for the sodium glycerophosphate of the reference produces unexpected results.

Art Unit: 1793

4. Claims 14-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (US Patent No. 2005/0258401 A1) in view of Ray (US Patent No. 4,098,614 A).

Lane et al was discussed previously.

Ray teaches that it is known to use various alkaline and alkaline earth metal glycerophosphates in cement compositions.

The instant claims are obvious over the combination of references. While the primary reference does not teach the use of lithium glycerophosphate it does teach that it is known to use sodium glycerophosphates as corrosion inhibitors in cement compositions having metallic reinforcements present. Since the secondary reference teaches that it is known to use various alkaline and alkaline earth metal glycerol-phosphates in cement compositions it is position of the examiner that Ray teaches the equivalency of lithium and sodium glycerophosphates. Also it should be noted that column 4, lines 45+ teaches that the glycerophosphates may be used in cement compositions that contain metallic material. While the secondary reference does not teach that the glycerophosphates are used as corrosion inhibitors, the new use of a known composition is not a patentable distinction if you have the composition. It is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA

Art Unit: 1793

1980); In re Swinehart, 439 F.2d 2109, 169 USPQ 226 (CCPA 1971). The applicants are also referred to the recent 2007 CAFC decision regarding Abbott Labs v Baxter Pharm Products Inc. The CAFC held that the new property of a prior art process does not render the process claim patentable. The CAFC reasoned that a claimed process having the same steps as a prior art process is not patentable simply because the claimed process identifies a **new advantageous property** of the prior art process. The CAFC stated their cases consistently held that a reference may anticipate even when the relevant properties of the thing disclosed were not appreciated at the time of the instant invention. As for the amounts of the components utilized one would find it obvious to utilize amounts that are effective to prevent corrosion. Accordingly the instant claims are obvious over the combination of references.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14-21 and 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14 the method is vague and indefinite as applicant has not provided an active positive method step as the phrase “is applied” is not an active positive method step.

In claim 20 the method is vague and indefinite as applicant has not provided an active positive method step as the phrase "are covered" is not an active positive method step.

***Information Disclosure Statement***

7. The information disclosure statement filed 01 April 2008 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant argues that the references were originally cited in the International Search Report and that it is applicant's understanding that applicants are not required to provide copies of the references as they have already been provided by the International Bureau.

While it is true that copies are not required if they have been provided by the International Bureau, in this instance copies were not provided by the International Bureau and accordingly the burden is on applicant to provide copies of the references that were not received.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J. Green/

Primary Examiner  
Art Unit 1793

ajg  
May 29, 2008